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OFFICE OF PETITIONS

In re Application of	:	
Kazuo Shiota et al.	:	
Application No. 09/954,964	:	DECISION ON PETITION
Filed: September 19, 2001	:	UNDER 37 C.F.R. §1.181(A)
Attorney Docket Number: 2091-	:	
0245P	:	
Title: NETWORK PHOTOGRAPH	:	
SERVICE SYSTEM	:	

This is a decision on the petition under 37 CFR §1.181(a), filed April 10, 2006, to withdraw the holding of abandonment.

Background

The above-identified application became abandoned for failure to file a proper response to the Requirement for Information, mailed July 15, 2005, which set a shortened statutory period to reply for two months. No extensions of time under the provisions of 37 C.F.R. 1.136(a) were received. Accordingly, the above-identified application became abandoned on September 16, 2005. A Notice of abandonment was mailed on February 13, 2006.

With the present petition pursuant to 37 C.F.R. §1.181(a), Petitioner has alleged that no response was submitted, because Applicant did not believe that a response was required. A discussion follows.

The Relevant Law, Regulations, and Portion of the MPEP

35 U.S.C. 133: Time for prosecuting application.

Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than

thirty days, as fixed by the Director in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Director that such delay was unavoidable.

(Amended Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-582 (S. 1948 sec. 4732(a)(10)(A)).)

37 C.F.R. §1.2: Business to be transacted in writing.

All business with the Patent and Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.

37 C.F.R. § 1.105 Requirements for information

(a)

(1) In the course of examining or treating a matter in a pending or abandoned application filed under 35 U.S.C. 111 or 371 (including a reissue application), in a patent, or in a reexamination proceeding, the examiner or other Office employee may require the submission, from individuals identified under § 1.56(c), or any assignee, of such information as may be reasonably necessary to properly examine or treat the matter, for example:

(i) Commercial databases: The existence of any particularly relevant commercial database known to any of the inventors that could be searched for a particular aspect of the invention.

(ii) Search: Whether a search of the prior art was made, and if so, what was searched.

(iii) Related information: A copy of any non-patent literature, published application, or patent (U.S. or foreign), by any of the inventors, that relates to the claimed invention.

(iv) Information used to draft application: A copy of any non-patent literature, published application, or patent (U.S. or foreign) that was used to draft the application.

(v) Information used in invention process: A copy of any non-patent literature, published application, or patent (U.S. or foreign) that was used in the invention process, such as by designing around or providing a solution to accomplish an invention result.

(vi) Improvements: Where the claimed invention is an improvement, identification of what is being improved.

(vii) In Use: Identification of any use of the claimed invention known to any of the inventors at the time the application was filed notwithstanding the date of the use.

(viii) Technical information known to applicant. Technical information known to applicant concerning the related art, the disclosure, the claimed subject matter, other factual information pertinent to patentability, or concerning the accuracy of the examiner's stated interpretation of such items.

(2) Where an assignee has asserted its right to prosecute pursuant to § 3.71(a) of this chapter, matters such as paragraphs (a)(1)(i), (iii), and (vii) of this section may also be applied to such assignee.

(3) Requirements for factual information known to applicant may be presented in any appropriate manner, for example:

(i) A requirement for factual information;

(ii) Interrogatories in the form of specific questions seeking applicant's factual knowledge; or

(iii) Stipulations as to facts with which the applicant may agree or disagree.

(4) Any reply to a requirement for information pursuant to this section that states either that the information required to be submitted is unknown to or is not readily available to the party or parties from which it was requested may be accepted as a complete reply.

(b) The requirement for information of paragraph (a)(1) of this section may be included in an Office action, or sent separately.

(c) A reply, or a failure to reply, to a requirement for information under this section will be governed by §§ 1.135 and 1.136.

[Removed and reserved, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997; added, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000; para. (a)(3) revised and paras. (a)(1)(viii) and (a)(4) added, 69 FR 56481, Sept. 21, 2004, effective Oct. 21, 2004]

§ 1.135: Abandonment for failure to reply within time period.

(a) If an applicant of a patent application fails to reply within the time period provided under § 1.134 and § 1.136, the application will become abandoned unless an Office action indicates otherwise.

(b) Prosecution of an application to save it from abandonment pursuant to paragraph (a) of this section must include such complete and proper reply as the condition of the application may require. The admission of, or refusal to admit, any amendment after final rejection or any amendment not responsive to the last action, or any related proceedings, will not operate to save the application from abandonment.

(c) When reply by the applicant is a bona fide attempt to advance the application to final action, and is substantially a complete reply to the non-final Office action, but consideration of some matter or compliance with some requirement has been inadvertently omitted, applicant may be given a new time period for reply under § 1.134 to supply the omission.

[Paras. (a), (b), and (c), 47 FR 41276, Sept. 17, 1982, effective Oct. 1, 1982; para. (d) deleted, 49 FR 555, Jan. 4, 1984, effective Apr. 1, 1984; revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997]

MPEP §502.03(V): Interviews.

Internet e-mail shall NOT be used to conduct an exchange of communications similar to those exchanged during telephone or personal interviews unless a written authorization has been given under Patent Internet Usage Policy Article 5 to use Internet e-mail. In such cases, a paper copy of the Internet e-mail contents MUST be made and placed in the patent application file, as required by the Federal Records Act, in the same manner as an Examiner Interview Summary Form is entered.

Analysis

With the present petition, Petitioner has asserted that he received the request for information, and was informed by the Examiner's supervisor that the applicants were "not required to file a reply to the Office Action dated July 15, 2005," as the "Examiner should be mailing a new Office Action for the subject application¹." Petitioner then sent an e-mail to the supervisor, the relevant portion of which is reproduced below:

To memorialize our recent phone conversation, it is our understanding that the USPTO will be mailing out a new office action in place of the Rule 105 Request for Information dated July 15, 2002. Therefore, our client does not need to Reply to the July 15, 2005 Request. It is also our understanding that we will be receiving a fax within the next week or so to further confirm the status of this case.

The Supervisor then sent a one word response: "confirmed."

Petitioner thus asserts that the Office improperly held the present application to be abandoned, as there was no need to file a response to the Request for Information.

The Office Petitioner's assertion is incorrect, for the following reasons.

First, regarding the e-mail which petitioner sent to the Supervisor of the Examiner, The Office cannot view this electronic communication as an acceptable method of exchanging information similar to a telephone or personal interview: the electronic file does not appear to contain a written authorization under Patent Internet Usage Policy Article 5 to use Internet e-mail, as required by MPEP §502.03(V). As such, Petitioner's communication with the Supervisor of the Examiner lies outside of the official channels of communication.

¹ Petition, page 1.

Secondly, *assuming arguendo* that the e-mail can be accepted and that it constitutes both a waiver by the Supervisor of Petitioner's need to respond to the Office action and a guarantee that a new Office action would be forthcoming, this still would not bring about the withdrawal of the holding of abandonment. The record has been reviewed, and it does not appear that the Request for Information of July 15, 2005 was ever withdrawn by the Office. The e-mail response from the Supervisor of the Examiner cannot serve to waive Petitioner's obligation to submit a response to the Request for Information, for the following reasons.

35 U.S.C. §133 is a self-executing law, which indicates that upon the failure of the applicant to prosecute the application within six months after any action therein, the application shall be regarded as abandoned by the parties thereto. Petitioner received a Request for Information which set a two-month period for response, and did not continue the prosecution of this application via the submission of a response. As such, the application went abandoned by operation of law, and it would be improper for this Office to withdraw the abandonment. Petitioner would have the Office withdraw the holding of abandonment based on the Supervisor's purported waiver of the need to respond to the Request for Information, but the Office does not have the authority to waive 35 U.S.C. §133. The power to waive or suspend the requirements of a statute is beyond the discretion or the authority of the Office².

Similarly, 37 C.F.R. §1.135 is a self-executing regulation which indicates that the failure to reply within the time period provided under 37 C.F.R. §§1.134 and § 1.136 will result in the abandonment of the application. Furthermore, Petitioner did not further prosecution of this application to save the same from abandonment, as an acceptable reply was not submitted in response to the Request for Information. As such, the application went abandoned by operation of law, and it would be improper for this Office to withdraw the abandonment. Petitioner would have the Office withdraw the holding of abandonment based on the Supervisor's purported waiver of the need to respond to the Request for Information, but a rule cannot

² See A. F. Stoddard & Co. v. Dann, 184 U.S. App. D.C. 71, 564 F.2d 556, 1977 U.S. App. LEXIS 11815, 195 U.S.P.Q. (BNA) 97 (1977) ("Executive Branch agencies, such as the PTO, having the obligation to carry out their duties under their authorizing statutes, and if they would avoid an exercise of the powers of another Branch, must in almost every case, follow the strict provisions of the applicable statute.").

be waived via the sending of an e-mail. The waiver of a rule is accomplished via obtaining a decision which grants a petition under 37 C.F.R. §183, and it does not appear that such a petition was ever filed.

CONCLUSION

For the reasons discussed above, the petition under 37 C.F.R. §1.181 must be **DISMISSED**.

Petitioner's only relief is a petition under 37 C.F.R. §§1.137(a) and or (b), and - having been made aware of this reality - Petitioner's delay in promptly seeking relief under 37 C.F.R. §1.137 may be considered evidence of intentional delay and an absolute bar to revival.

NOTICE:

Any renewed petition under 37 C.F.R. §1.181 must be submitted within **TWO (2) MONTHS** from the mail date of this decision. Extensions of time under 37 C.F.R. §1.136(a) are permitted. Failure to respond will result in abandonment of the application. The renewed petition should include a cover letter entitled " Renewed Petition under 37 C.F.R. §1.181," and should only address the deficiencies noted in this decision.

Thereafter, there will be no further reconsideration of this matter^{3, 4}.

³ For more than a century, punctuality and due diligence, equally with good faith, have been deemed essential requisites to the success of those who seek to obtain the special privileges of the patent law, and they are demanded in the interest of the public and for the protection of rival inventors. See: Porter v. Loudon, 7 App.D.C. 64 (C.A.D.C. 1895), citing Wollensak v. Sargent, 151 U.S. 221, 228, 38 L. Ed. 137, 14 S. Ct. 291 (1894). An invention benefits no one unless it is made public, and the rule of diligence should be so applied as to encourage reasonable promptness in conferring this benefit upon the public. Automatic Electric Co. v. Dyson, 52 App. D.C. 82; 281 F. 586 (C.A.D.C. 1922). Generally, 35 U.S.C. §6; 37 C.F.R. §§1.181, 182, 183.

⁴ If, on the second request for reconsideration, Petitioner fails to satisfy the showings burden required: (a) the resulting decision may be one viewed as final agency action; and (b) provisions for reconsideration, such as those at 37 C.F.R. §1.137(e), will **not** apply to that decision.

The renewed petition should indicate in a prominent manner that the attorney handling this matter is Paul Shanowski, and may be submitted by mail⁵, hand-delivery⁶, or facsimile⁷.

ALTERNATE VENUE

Petitioner may also wish to consider filing a petition under 37 C.F.R. §§1.137(a) and/or (b).



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7 (571) 273-8300- please note this is a central facsimile number.